

REMARKS

Claims 1-27 are pending in the present application. Independent claims 1 and 17 have been amended. No new matter has been added. Support for the amendments may be found between line 17 on page 6 and line 23 on page 7 of the Patent Application and in Figure 3.

In the Final Office Action, claims 1 and 17 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Tiedemann et al (U.S. Patent No. 6,982,971). Claims 2-15 and 18-27 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Tiedemann in view of Blackeney II et al (U.S. Patent No. 5,267,261). Claim 16 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Tiedemann in view of Blackeney further in view of Sekine et al (U.S. Pub. No. 2001/0024429). The Examiner's rejections are respectfully traversed.

Independent claim 1 teaches a method for controlling a communications system by communicating with a first base station using signals synchronized with a first synchronizing signal, communicating concurrently with a plurality of base stations including the first base station using signals synchronized with the first synchronizing signal during a hand off period communicating with a second base station in the plurality of base stations using signals synchronized with a second synchronizing signal after the hand off period, and communicating with a plurality of Radio Network Controllers using signals to forward timing information about neighboring communication cells. Applicant's invention provides a method in which a plurality of Radio Network Controllers (RNCs) are used to forward timing information about neighboring communications cells to a UE. This information can be stored and used for future SHO operations increasing efficiency. See Application, page 7, lines 5-23. In contrast, Tiedemann is completely silent on the use of any number of RNCs for communication of timing signals, and strictly confines itself to communication between the base stations and the mobile unit. For at

least these reasons, Applicants respectfully submit that Tiedemann fails to anticipate all the aspects of claims 1 and 17 as stated in the instant Application.

For at least the aforementioned reasons, Applicants respectfully submit that the present invention is not anticipated by Tiedemann and request that the Examiner's rejections of claims 1 and 17 under 35 U.S.C. § 102(b) be withdrawn.

Claims 2-15 and 18-27 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Tiedemann in view of Blackeney II et al (U.S. Patent No. 5,267,261). Claim 16 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Tiedemann in view of Blackeney further in view of Sekine et al (U.S. Pub. No. 2001/0024429). It is respectfully submitted that the pending claims 2-15 and 18-27 are not obvious in view of Tiedemann and Blackeney, either alone or in combination, and pending claim 16 is not obvious in view of Tiedemann and Blackeney further in view of Sekine.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Moreover, the differences between the prior art and the subject matter to be patented as a whole must not have been obvious to at the time of invention to a person of ordinary skill in the art. 35 U.S.C. § 103(a). To determine whether the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made, one should determine whether the prior art reference (or references when combined) teach or suggest all the claim limitations. Applicant respectfully submits that in making an obviousness rejection, it is necessary for the Examiner to identify the reason why a person of ordinary skill in the art would have combined the prior art references in the manner set forth in the claims. The required reason may be provided by some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art,

to modify the reference or to combine reference teachings. Thus, the absence of a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings may be evidence that the claims are not obvious. Teaching away by the prior art may constitute *prima facie* evidence that the claimed invention is not obvious.

As discussed above, Tiedemann fails to teach or suggest communicating with any number of RNCs in regard to timing signals as disclosed in claims 1 and 17 and the specification. Blackeney and Sekine have the same deficiencies. Blackeney and Sekine are completely silent with respect to communicating with any number of RNCs in regard to timing signals. Therefore, as claims 2-16 and claims 18-27 are dependent on claims 1 and 17 respectively, Tiedemann and Blackeney and Sekine, taken together or separately or in combination, fail to teach or suggest all of the limitations claimed therein. Tiedemann and Blackeney and Sekine, to the contrary, teach away from the amended claims 1 and 17. Where Tiedemann and Blackeney teach a closed loop of communication between base stations and a mobile unit that excludes the possibility of a base station receiving synchronization signals for neighboring base stations from a radio network controller, the instant invention breaks free of their teachings and communicates outside with a plurality of Radio Network Controllers using signals to forward timing information about neighboring communication cells. See Application, Figure 3, page 6 line 17 to page 7 line 23.

Furthermore, where Tiedemann and Blackeney and Sekine are completely silent on a plurality of Radio Network Controllers using signals to forward timing information about neighboring communication cells, there can be no combination of the prior art to support an argument of obviousness. Applicant also respectfully submits that the Examiner has failed to show why a person of ordinary skill in the art would modify Tiedemann and Blackeney and Sekine to arrive at the instant invention. Tiedemann and Blackeney and Sekine offer no

motivation in themselves, being completely silent in regards to Radio Network Controller communications, and further, the RNC communications go beyond the scope of normal base station to base station signal transfers as disclosed by the prior art.

For at least the aforementioned reasons, Applicants respectfully submit that the present invention is not obvious over the prior art of record and request that the Examiner's rejections of claims 14-16 and 25-27 under 35 U.S.C. § 103(a) be withdrawn.

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-7000 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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